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Serial No. 09/887,836
Reply Brief

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Attorney Docket No. CFP-31802/02

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant: James S. Bradley

Serial No.: 09/887,836

Group Art Unit: 1772

Filed: June 22, 2001

Examiner: Walter Aughenbaugh

For: LAMINATE ANTIOXIDANT FILM

REPLY BRIEF AND REQUEST FOR ORAL ARGUMENT

Mail Stop Reply Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is Appellant's reply brief made in response to Examiner's Answer having a mailing date of July 9, 2004, which in turn was responsive to Appellant's Appeal Brief having a mailing date of May 3, 2004.

The substance of Appellant's Appeal Brief being herein incorporated by reference, Appellant respectfully submits the following additional remarks in response to Examiner's Answer.

I. Status of Amendments After Final

An amendment was filed in response to the final rejections in the Office Action having a mailing date of November 4, 2003. In the Advisory Action having a mailing date of February 4, 2004, the claim amendments, particularly the amendment to claim 11, were not entered because

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they were asserted to raise new issues that would require further consideration and/or search, and they were not deemed to place the application in better form for appeal. This position was traversed in Appellant's brief. Claim 11 remains rejected, as it was not entered for reasons detailed in section (4) of Examiner's Answer.

Claim 11 was amended in the reply to final in a manner that changed the claim from a product claim to a product-by-process claim. Original claim 11 was a product claim defining an "antioxidant adhesive film comprising: . . . a solventless cured adhesive resin . . . ; and a butylated phenolic antioxidant" Amended claim 11 is a product-by-process claim defining an "antioxidant adhesive film formed by the process comprising the step of: applying a solventless cured adhesive resin . . . ; and a butylated phenolic antioxidant . . . on a substrate." Examiner asserts that there is no connection in the claim as amended after-final between the step of applying the solventless cured adhesive resin and the antioxidant. Appellant respectfully disagrees with Examiner on this point, as it should be appreciated that the antioxidant is, indeed, directly connected to the step of applying the solventless cured adhesive resin, i.e. the antioxidant along with the solventless cured adhesive resin are applied on a substrate.

Examiner argues that the after-final amendment to claim 11 raises new issues, since original claim 11 required the antioxidant adhesive film to have both the adhesive resin and the antioxidant. Again, Appellant respectfully disagrees. As highlighted above, amended claim 11 defines an antioxidant adhesive film formed by the process comprising the step of applying a solventless cured adhesive resin and an antioxidant on a substrate. That is, the antioxidant adhesive film resulting from the process includes a substrate having the solventless cured adhesive resin and the antioxidant applied thereon.

Appellant respectfully maintains that after-final amendments to claim 11 filed in our response to the Office Action having a mailing date of November 4, 2003 simply changed the type of claim being presented rather than the subject matter being claimed. Appellant invites the Board to remand the case back to the Examiner to have the amendment entered as it does not alter the claim in a manner that raises new issues or renders the claim indefinite as asserted in the Advisory Action.

II. Grouping of Claims

In his Answer, Examiner stated that claims 1-5 and 11 stand or fall together because Appellant's brief does not include a statement otherwise. Appellant respectfully traverses. In accordance with 37 CFR 1.192(c)(7), Appellant provided in section VII of the Appeal Brief mailed on May 3, 2004 that claims 1-5 will stand or fall together as a result of this appeal; and claim 11 will either stand or fall as a result of this appeal. Further, Appellant requested in the Brief that claim 12 be withdrawn from further consideration.

III. Response to Arguments

A. Claims 1-5

Claims 1-5 remain rejected under 35 U.S.C. §103(a) over Saad et al. (United States Patent 5,562,874) in view of Satoh et al. (United States Patent 6,194,061 B1).

Examiner asserts that it would have been obvious to one of ordinary skill in the art to combine the prior art references of Saad et al. and Satoh et al. to arrive at the subject matter of claims 1-5. More specifically, Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the adhesive layer as taught by Saad et al., which lacked the curing agent, with the adhesion layer composition as taught by Satoh et al., which comprises polyester, polyurethane and a curing agent. The

adhesion layer of Satoh et al. does not, however, include the butylated phenolic antioxidant. That is, neither Satoh et al. nor Saad et al. teaches the adhesive layer of claim 1 comprising the mixture of adhesive resin, the curing agent and the butylated phenolic antioxidant. Satoh et al. makes only one mention of the word antioxidant (col. 4, line 15), but does so only in reference as a possible additive to the substrate film or outer layer. Satoh et al. does not teach the use of any antioxidant as part of a mixture defining the adhesion layer. As such, Appellant respectfully asserts that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to replace the adhesive layer in Saad et al. with the adhesion layer of Satoh et al. to arrive at the packaging laminate of claims 1-5. Such a combination would still lack the butylated phenolic antioxidant, as required by claims 1-5.

Examiner further asserts “the method of forming the laminate of Saad et al. that is taught by Saad et al. is not germane to the issue of patentability of the laminate itself.” Examiner continues that, “Saad et al. teach a laminate, and laminates are made by other processes besides coextrusion.” Saad et al., however, teach coextrusion as the only method of producing the laminate taught by Saad et al. No other method of producing the laminate taught by Saad et al. is mentioned or suggested in Saad et al. Appellant respectfully asserts that the method of forming the laminate of Saad et al. is absolutely germane to the issue of patentability of the packaging laminate of claims 1-5. Specifically, the method of forming the laminate of Saad et al. is relevant to motivation, or a lack thereof, to make the combination suggested by Examiner. It must be shown that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the manner as suggested by Examiner. In other words, the Examiner must show some suggestion or motivation, before the invention itself, to make the new combination. *In*

re Rouffet, 149 F.3d 1350, 1355- 56 (Fed. Cir. 1998). It is well recognized that such suggestion or motivation must be found in the prior art references themselves. Appellant respectfully asserts that Saad et al. and Satoh et al. lack the required motivation to make the combination as suggested by Examiner to arrive at the subject matter of claims 1-5.

In Satoh et al., the adhesion layer includes a polyester graft copolymer and a resin. The polyester graft copolymer is detailed to be in the form of a dispersion or solution in an organic or aqueous solvent. (Column 7, lines 42-52). With a cross linking agent present, the dispersion or solution is applied to a thermoplastic film substrate and dried during which time cross linking occurs, resulting in a solid content film of 1 to 50 weight percent of the initial dispersion or solution (column 17, lines 33-42). Examiner suggests replacing the adhesive layer in Saad et al. with the dispersion or solution of polyester copolymer and resin of Satoh et al. to form Appellant's claimed packaging laminate. Such a combination, however, would be met with failure when an attempt is made to process the combination using coextrusion, which is the only method or process taught by Saad et al. to form the laminate taught by Saad et al. Saad et al. does not teach, suggest nor provide motivation to form the laminate taught by Saad et al. using any other processes known by those of ordinary skill in the art, including those taught by Satoh et al. and by Appellant in the Appeal Brief.

Examiner asserts that one of ordinary skill in the art would have recognized to have used the coating process of Satoh et al. to form the laminate structure taught by Saad et al. Satoh et al. does not teach, suggest nor provide motivation to produce the laminate structure taught by Saad et al. using the coating process of Satoh et al. Further, Saad et al. does not teach, suggest nor provide motivation to produce the laminate structure taught by Saad et al. using any process or method other than that taught by Saad et al., i.e. coextrusion. Examiner's position to the contrary is nowhere supported in the cited prior art references nor in well established law with respect to obviousness.

Accordingly, Appellant respectfully asserts that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to replace the adhesive layer in Saad et al. with the adhesion layer of Satoh et al. to arrive at the packaging laminate of claims 1-5, because (1) one of ordinary skill in the art would not find suggestion in either Saad et al. or Satoh et al. to make such a combination; and (2) it would not have been revealed in either Saad et al. or Satoh et al. that one of ordinary skill in the art would have a reasonable expectation of success in making such a combination, as suggested by Examiner. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Appellant asserts that to take a contrary position is submitted to represent hindsight reasoning, involving picking and choosing among the individual elements of the prior art references of record, and such an approach is contrary to the law regarding obviousness. *Symbol Technologies, Inc. v. Opticon, Inc.*, 935 F.2d 1569, 19 USPQ2d 1241 (Fed. Cir. 1991). *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 69 U.S.P.Q.2D (BNA) 1686 (Fed. Cir. 2004).

B. Claim 11

As it stands, claim 11 defines an antioxidant adhesive film comprising: a solventless cured adhesive resin selected from the group consisting of: polyether urethanes, polyester urethanes, and polyurethane; and a butylated phenolic antioxidant present in a concentration of between 1000 and 300,000 parts per million applied from 0.00005 to 0.001 dry pounds per square foot of a substrate.

According to Examiner, Omura et al. teach an adhesive composition comprising a resin, a curing agent and a butylated hydroxytoluene antioxidant. But, Omura et al. does not teach that the adhesive resin is cured solventlessly; does not teach that the adhesive resin is selected from the group set forth in claim 11; and does not teach that the adhesive resin is applied from 0.00005 to 0.001 dry pounds per square foot of a substrate.

According to Examiner, Satoh et al. disclose a laminate film having an adhesion layer or composition. The adhesive composition of Satoh et al. is formed from a resin composition comprising a polyester graft copolymer and a resin. Examiner asserts in section 18 of Paper 9 that it would have been obvious to one of ordinary skill in the art to replace the adhesive composition taught by Omura et al. with the adhesive composition taught by Satoh et al., i.e. the polyester graft copolymer and resin. Appellant has been left to assume that the proposed combination results in the antioxidant adhesive film defined in claim 11, and as such, Appellant respectfully disagrees.

Appellant now asserts that replacement of the adhesive composition of Omura et al. with the adhesive composition of Satoh et al. does not result in the laminate film of claim 11. Omura et al. teaches an adhesive composition and nothing more. Therefore, replacing the adhesive composition of Omura et al. with a replacement adhesive composition results only in the replacement adhesive composition. Stated differently, if one removes the adhesive composition of Omura et al. and inserts the adhesive composition of Satoh et al., then one is left with the adhesive composition of Satoh et al. – not the laminate film of claim 11 as asserted by Examiner.

As previously asserted, claim 11 recites a product claim indicating that the adhesive resin applied is applied in a solventless form as opposed to applying a solvated adhesive that is subsequently dried on the substrate as per Satoh et al. As the prior art combination of Omura et al. and Satoh is completely lacking in teaching a solventless application of resin, it is respectfully submitted that claim 11 is in allowable form. Further, Appellant submits that if the Board decides to remand the present case to the Examiner for entering the after-final amendment, then amended claim 11 would also be in allowable form for substantially the same reasoning.

IV. Conclusion

From the foregoing, and for reasons set forth in the Appeal Brief, Appellant respectfully submits that claims 1-5 each embody patentable subject matter and are in condition for allowance. Further, in view of the foregoing remarks with regard to amended claim 11, Appellant respectfully invites the Board to remand the case back to the Examiner to have the amendment entered and order the claims as presented therein be allowed. Accordingly, such action is respectfully requested.

V. Request for Oral Argument

Appellant hereby formally requests the privilege of an oral argument with respect to the above-referenced application.

Enclosed is a check in the amount of \$145.00 to cover the Request for Oral Hearing fee. Should there be a deficiency or overpayment in this amount, the Commissioner is hereby authorized to charge/credit Deposit Account No. 07-1180.

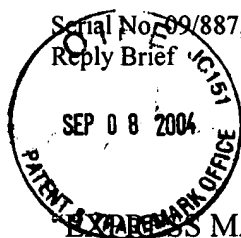
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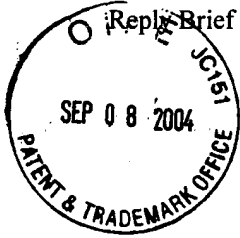
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DATE OF DEPOSIT September 8, 2004

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Janice R. Kuehn
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APPENDIX A

CLAIMS ON APPEAL

1. A packaging laminate comprising an outer layer impermeable to a butylated phenolic antioxidant; an adhesive layer between said outer layer and an inner layer and in contact with both said outer layer and said inner layer to form said packaging laminate, wherein said adhesive layer comprises an adhesive resin, a curing agent and said butylated phenolic antioxidant; and said inner layer allowing migration of said butylated phenolic antioxidant therethrough.

2. The packaging laminate of claim 1 wherein the outer layer is selected from a group consisting of: polyvinylidene chloride (PVDC) coated polyester, PVDC coated polypropylene, aluminum coated polyethylene terephthalate (PET), polyethylene (PE), oriented polypropylene (OPP), nylon, aluminum oxide coated PET, aluminum oxide coated polyester, acrylic coated polypropylene and PET, layers thereof, coatings thereof, and combinations thereof.

3. The packaging laminate of claim 1 wherein said adhesive resin is selected from a group consisting of: polyether urethanes, polyester urethanes, and polyurethane.

4. The packaging laminate of claim 1 wherein said curing agent is selected from a group consisting of: polyamines, polyols, isocyanates, and organometallics.

5. The packaging laminate of claim 1 wherein said butylated phenolic antioxidant is selected from a group consisting of butylated hydroxytoluene and butylated hydroxyanisole.

11. An antioxidant adhesive film comprising: a solventless cured adhesive resin selected from the group consisting of: polyether urethanes, polyester urethanes, and polyurethane; and a butylated phenolic antioxidant present in a concentration of between 1000 and 300,000 parts per million applied from 0.00005 to 0.001 dry pounds per square foot of a substrate.

12. A resealable package comprising:
an outer layer defining sides and an interior volume; and
a flap extending from at least one of the sides, said flap adapted to fold against said outer layer and having a resealable peel antioxidant adhesive applied to a surface of said flap wherein said adhesive comprises a solventless cured adhesive resin selected from the group consisting of: polyether urethanes, polyester urethanes and polyurethane having a vapor transmission rate of greater than 0.2 grams per 100 square inches per day at 70°F; and a butylated phenolic antioxidant present in a concentration of between 1000 and 100,000 parts per million.